

REMARKS/ARGUMENTS

Favorable consideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-38 are pending in the application, with Claims 7-8, 12-13, 16-23 and 27-34 amended by the present amendment.

In the outstanding Office Action, Claims 27-34 were objected to; Claims 22, 25, and 27-38 were rejected under 35 U.S.C. § 112, second paragraph; Claims 1-23 and 27-38 were rejected under 35 U.S.C. § 102(e) as being anticipated by Hayward et al. (U.S. Patent No. 6,798,997; hereinafter "Hayward"); Claims 24-26 were rejected under 35 U.S.C. § 103(a) as being anticipated over Hayward and Benjamin et al. (U.S. Patent No. 6,113,208; hereinafter "Benjamin").

Applicants request an acknowledgement of the IDS filed on March 14, 2005.

Claims 27-34 are amended to correct the informality noted in the Official Action. In response to under 35 U.S.C. § 112, second paragraph, Claims 7-8, 12-13, 16-23 and 27-34 are amended to more clearly describe and distinctly claim Applicants' invention.

Applicants submit that Hayward is not a valid reference under 35 U.S.C. § 102(e). Applicants claim priority to two Japanese patent applications, one of which (JP 2000-242737) was filed on August 10, 2000, which is before the September 14, 2000 filing date of Hayward. Applicants note that Hayward is a continuation-in-part of Application Serial No. 0/397,136, filed on September 16, 1999. However, the Official Action presents no evidence that Application Serial No. 0/397,136 contains the information relied upon for the outstanding rejection under 35 U.S.C. § 102(e).<sup>1</sup> That is, the Official Action provides no evidence that the priority date of the information relied upon for the outstanding rejection under 35 U.S.C. § 102(e) is September 16, 1999. In view of the fact that the priority

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<sup>1</sup> MPEP 2136.03.IV and In re Werthheim

document of Hayward was not cited in the Official Action, Applicants assert that the priority date of the information relied upon for the outstanding rejection under 35 U.S.C. § 102(e) is September 14, 2000, which is after Applicants' priority date of August 10, 2000. A translation of Japanese Priority Document 2000-242737 is filed herewith.

Also, Applicants traverse the assertion that the "Buy Now" and "Maintenance" buttons of Hayward correspond to Applicants' claimed "store purchase" mode recited at least in Claim 2. Applicants' store purchase mode is a method of reserving an item for pick-up at a store.<sup>2</sup> Hayward discloses no button for reserving a time for pick-up. Similarly, Applicants traverse the assertion that the "Buy Now" and "Maintenance" buttons of Hayward correspond to Applicants' claimed "plurality of options concerning the purchase mode" as recited at least in Claim 3. Hayward only discloses a single purchase option, "Buy Now," which is accessible by one of two screens.<sup>3</sup> Once the order is placed, the manufacturer has the option of shipping directly or requesting a dealer to ship the consumable item.<sup>4</sup> Hayward does not disclose or suggest a button for reserving an item for pick-up.

MPEP § 2131 notes that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit"

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<sup>2</sup> Specification, page 35, line 13 – page 36, line 11.

<sup>3</sup> Hayward, Figure 4; column 7, lines 54-60.

<sup>4</sup> Hayward, column 8, lines 46-53.

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representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02. "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Assuming *arguendo* that Hayward is a valid reference under 35 U.S.C. § 102(e), because Hayward does not disclose or suggest all the features recited in Claims 1-4, Hayward does not anticipate the invention recited in Claims 1-4, and all claims depending therefrom.

Accordingly, in view of the present amendment and in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.

Respectfully submitted,

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